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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,619	02/05/2001	Motoyuki Hirata	Q62599	8354

7590

06/04/2003

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EXAMINER

LORENZO, JERRY A

ART UNIT

PAPER NUMBER

1734

5

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

ink-5

Office Action Summary

Application N .

09/775,619

Applicant(s)

HIRATA ET AL.

Examiner

Jerry A. Lorengo

Art Unit

1734

-- The MAILING DATE of this communication appears in the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/014,572.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The rejection of claims 17-33 under 35 U.S.C. 112, second paragraph, as generally set forth in the first office action mailed December 18, 2002, stands.

(2)

Claim Rejections - 35 USC § 103

The rejection of claims 17-33 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,858,264 to Ichino et al., as generally set forth in the first office action mailed December 18, 2002, stands.

(3)

Response to Arguments

Applicant's arguments filed March 18, 2003 have been fully considered but they are not persuasive.

The applicants' arguments can be summarized into two general categories:

1. That the rejection of claims 17-33 under the second paragraph of 35 USC § 112 is improper because the claims recite steps directed not only to the impregnated electrode, but also recite steps to the provision of an electrode that is contained in the battery; and
2. That the rejection of claims 17-33 under 35 USC 103(a) as obvious over U.S. Patent No. 5,858,264 to Ichino et al. is improper because while Ichino et al. discloses a polymer solution coated on a porous membrane and impregnated under vacuum into the porous membrane, the instant invention is concerned with the fixing of a solid polymer electrolyte film to a porous electrode by reducing pressure inside the porous electrode.

With regards to point 1 above, the examiner respectfully submits that the rejection of claims 17-33 under the second paragraph of 35 USC § 112 is proper because while the applicants are attempting to claim a battery, they are only disclosing steps useful in the formation of an electrode, a mere component of the battery. This would be analogous to one claiming an automobile while only disclosing steps useful in the formation of a tire. Although the applicants argue that the claims "also recite steps to the provision of an electrode that is contained in the battery," the examiner respectfully submits that each and every one of the independent claims (claims 17, 18, 30 and 31) recite the same preamble: "A battery obtained by a method

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comprising the steps of.” Because the claims fail to set forth the other essential components or steps needed to form a battery, they are indefinite and are properly rejected as such.

With regards to point 2, above, the examiner respectfully agrees that Ichino et al. and the instant invention differ in that Ichino et al. utilizes a pre-polymer electrolyte film while the instant invention uses, at least in applicant claims 17 and 30) and solid polymer electrolyte film. Nonetheless, the examiner respectfully submits that since both Ichino et al. and the instant invention utilize a reduced pressure within the porous film to bond the polymer electrolyte film (be is a solid or pre-solid) one of ordinary skill in the art at the time of invention, as set forth in the first office action, that the electrolyte impregnation could have occurred under vacuum motivated by the fact that the skilled artisan and Ichino et al. disclose that vacuum impregnation, at least with regards to the use of the polymerizable electrolyte film, enable the material to be introduced more efficiently and completely into the structure. Therefore, the examiner respectfully submits that claims 17-33 have been properly rejected as obvious over Ichino et al. and this rejection is made final. Finally, the applicant should note that the claims are essentially product claims and as such the method of formation is given very little or no patentable weight.

(4)

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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(5)

Applicant is encouraged to **FAX After Final Amendments** (37 CFR 1.116) to expedite delivery to the Examiner. The Group 1734 Facsimile number is **(703) 872-9311**. A duplicate mailed copy of the facsimile transmission is **not required** and will only serve to delay the processing of your application.

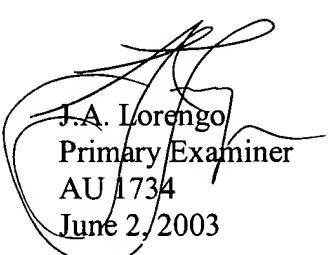
If the applicant prefers to mail in After Final correspondence it is highly recommended that such be mailed to **BOX AF** which will also facilitate processing from the mailroom and within Group 1700.

(6)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry A. Lorengo whose telephone number is (703) 306-9172. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (703) 308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7115 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



J.A. Lorengo
Primary Examiner
AU 1734
June 2, 2003